

Arguments/Remarks

Claims 4-5, 13, 14, and 16 are pending and currently stand rejected. Claims 1-3, 8-12, 15, and 18 have been withdrawn as being directed to non-elected subject matter. Claims 6, 7, and 17 have been cancelled. Applicants acknowledge election of the compound shown in example 25, table 6 as representative species. Reconsideration and withdrawal of the rejections are requested.

Rejections under 35 U.S.C. §112

Claims 4-7 and 13-14 have been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner indicates that the phrase "small cycloalkyl" is not definite, the use of the terms, "e.g.," "such as," or "preferably" is indefinite, and the lack of alternative language for different R₆ definitions in claim 5 is indefinite.

Applicants have amended the claims. Claims 6-7 have been cancelled, and their limitations incorporated into claim 4. This amendment is cosmetic because the limitations of amended claims 4-5 are identical to those previously presented in the previous claims. There is no basis in the action to support the notion that one of ordinary skill in the art would not have understood the scope of the claims as is necessary to support the 35 U.S.C. §112 rejections. While the choice of language may not have been consistent, the inconsistency was not such that one of ordinary skill in the art would not have understood the scope of the claim. The amendment corrects the objectionable form. Should the examiner disagree with this distinction and remain of the opinion that the appropriate way to deal with claims 4-7 were by section 112 rejection and not by objection, it is requested that applicant be so advised. Otherwise, applicant will assume that the examiner agrees with applicant's position.

Withdrawal and reconsideration are requested.

Claims 4-7 and 13-14 have also been rejected as under 35 U.S.C. §112 first paragraph as failing to comply with the enablement requirement. More particularly the Examiner claims applicants have not disclosed how to make and use the full scope of the claimed invention.

In response thereto, applicants have amended claim 4 to limit R² to naphthalynyl and benzothiazolyl, i.e., more narrowly tailored to cover specific examples shown in the application.

It is well established that as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement is satisfied (See *In re Fisher*, 427 F.2d 833).

The Examiner is correct in citing the *In Re Wands* factors for enablement. As mentioned above, Applicants have amended the claims to accordingly limit the scope of R². In view of the teaching of the specification and the narrowing of R², one of skill in the art could therefore make the current claim scope without undue experimentation. Withdrawal and reconsideration are respectfully requested.

The application is now in condition for examination and passage to allowance. Should the Examiner have any questions, please contact the undersigned.

Respectfully submitted,



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